

II. REJECTION UNDER 35 U.S.C. § 102

Claims 1-3, 10-12, 19-21 and 28-31 have been rejected under 35 U.S.C. § 102 as being anticipated by *Berstis, et al.*, U.S. Patent No. 6,115,745 ("*Berstis*"). The Applicant respectfully traverses the rejection of claims 1-3, 10-12, 19-21 and 28-31 under 35 U.S.C. § 102.

Considering claim 1, claim 1 is directed to a method of servicing a network request. The method includes determining availability of resource capacity in response to the network request, and allocating a scheduled time for resending the network request by a client initiating the request. *Berstis* is said to teach the step of determining availability of resources, and allocating a scheduled time to process a data transfer request. (Paper No. 3, pages 2-3) (citing *Berstis* at column 5, lines 30-40 and column 6, lines 17-20). As the Applicants have previously discussed, the disclosure referred to by the Examiner is directed to an agent scheduling function that is implemented on a network client. (Applicants' Reply Under 37 C.F.R. § 1.111, mailed October 3, 2002 (the "Applicants' First Reply"), page 3) (citing *Berstis*, column 5, lines 23-40). Thus, as previously shown, the teaching in *Berstis* would not be understood by one of ordinary skill in the art to disclose determining availability of resource capacity in response to a network request. A network client does not service its own request. (Applicants' First Reply, page 3.) Additionally, the Applicant notes that the limitation in claim 1 with respect to the response to a network request is not addressed in the rejection of claim 1. (Applicants' First Reply, page 3) (citing Paper No. 3, page 3; Paper No. 5, pages 2-3.)

With respect to the step of allocating a scheduled time for resending..., the Examiner contends, as noted above, that *Berstis* teaches allocating a scheduled time to process a data transfer request. (Paper No. 3, page 2; Paper No. 5, page 2.) Thus, by its plain terms, the alleged teaching in *Berstis* does not address the limitation of claim 1. (Applicants' First Reply, page 3.) Claim 1 does not recite allocating a time to process a data transfer request. Neither would *Berstis* be expected to teach the step of allocating as recited in claim 1, because the disclosure in *Berstis* is directed to an

agent implemented as a network client. *Berstis*, column 4, lines 39-40.) There is no reason for a client to send requests to itself, nothing has been identified as showing the client sending requests to itself, consequently, *Berstis* would not be expected to be responsive to a network request. Additionally, *Berstis* discloses that if a given client machine is not able to obtain one of a limited number of telephone connections, a map of available agent start times, which is maintained by the agent, is regenerated. Thus, the disclosure in *Berstis* cannot teach the steps of claim 1 because no request could have been initiated.

The Examiner responds that "references are not read in a vacuum, but must be taken in the context of what was reasonable based on the subject matter as a whole as would have been understood at the time the invention was made to a person of ordinary skill in the art." (Paper No. 5, page 5.)¹ The Examiner provides no authority for this proposition. (Paper No. 5, page 5.) Anticipation requires that a single prior art reference teach the identical invention as in the claim. MPEP § 2131. Although an Examiner may rely on a secondary reference to explain the meaning of a term used in the primary reference to establish that a characteristic not disclosed in the primary reference is inherent, neither pertains in the instant Office Action, Paper No. 5. See MPEP § 2131.01; Paper No. 5, page 5. The Examiner simply asserts, that "numerous network requests are taught , col. 4, lines 54-67, that are serviced by servers, ISPs, etc." (Paper No. 5, page 5.) This assertion fails for several reasons.

As an initial matter, the Applicants note that the assertions with respect to servers, etc. are not found in *Berstis* but are Examiner argument. The citation to *Berstis* refers to activities of a Web agent, such as prefetching web content during off-line hours, filtering content, downloading client software upgrades or fixes and downloading e-mail. (*Berstis*, column 4, lines 54-67.)

¹ The Examiner also states that the limited structure claimed, without more functional language reads on the references provided. (Paper No. 5, page 5.) Anticipation requires that a single reference teach all of the claim limitations, arranged as required thereby. MPEP § 2131. Thus a *prima facie* showing of anticipation necessarily requires comparing the claims and the reference, and is not established by such general allegations.

Additionally, the assertion does not address the Applicants' showings. The allegation is an unsupported conclusion with respect to servers, ISPs, etc. and have nothing to do with a client as taught in *Berstis*, and the Examiner provides no rationale explaining how these refute the Applicants' showings that the client in *Berstis* upon which, *inter alia*, claim 1 has been rejected would not service its own requests.

Claim 2 depends from claim 1 and recites the method thereof in which the step of allocating a scheduled time includes selecting the scheduled time, and notifying the client to resend the network request at the scheduled time. Claim 2 has been rejected on the assertion that *Berstis* teaches selecting a notification of a time slot. (Paper No. 3, page 3; Paper No. 5, page 3) (citing *Berstis*, column 5, line 40 and lines 50-52). The teaching in *Berstis* referred to discloses a map or agent load table, and if the outcome of a test to determine whether the agent is able to obtain one of the limited number of network connections, to initiate agent activity. (Applicants' First Reply, page 4) (citing *Berstis*, column 4, line 40 and lines 47-52). Thus, by their plain terms, the teachings relied upon do not disclose selecting a notification of a time slot. Furthermore, claim 2 recites the limitation of notifying the client to resend the network request. As noted hereinabove, *Berstis* is directed to an agent running on a client machine. Thus, *Berstis* would not be expected to teach a step of notifying the client to resend the network request at the scheduled time because there is no logical reason for the agent to send a notification to itself. Thus, for at least the aforesaid reasons, the Applicant respectfully contends that *Berstis* does not teach the identical invention of claim 2. Therefore, claim 2 is allowable under 35 U.S.C. § 102 over *Berstis*. Claims 11 and 20 have been rejected on the same basis as claim 2. (Paper No. 3, page 3.) The Applicant understands that these claims have been rejected as being directed to a data processing system and computer program product respectively including circuitry and programming instructions for performing operations paralleling the method steps of claim 2. Thus the Applicant respectfully asserts that claims 11 and 20 are also allowable under 35 U.S.C. § 102 over *Berstis* for at least the reasons discussed in conjunction with claim 2.

The Examiner responds that *Berstis* teaches that a test is made to determine whether updated usage statistics have been received by the central authority... or a set of agent start times... *the agent* then selects an agent start time from the new map [preselected slot times]." (Paper No. 5, pages 5-6) (emphasis added). As the Examiner admits, it is the agent that selects the agent start time. This is evidence that *Berstis* does not teach selecting a notification of a time slot and notifying the client to resend the network request, as recited in claim 2 because it is illogical for the client to notify itself, as the Applicants have discussed in the Applicants First Reply and hereinabove. In fact, the Examiner has identified no such teaching, and has not addressed this analysis in the Examiner's response. (See Paper No. 5, pages 5-6.)

Claim 3 further depends from claim 2 and recites the method thereof in which the step of selecting the scheduled time includes the step of selecting the scheduled time from a preselected plurality of time slots. Claim 3 has been rejected on the identical basis as claim 1. (Paper No. 3, page 2; Paper No 5, page 2.) However, no teaching has been identified in rejecting claim 1 that allegedly discloses the step of selecting the scheduled time from a preselected plurality of time slots. Furthermore, claim 3 depends from an allowable base claim, or an intervening claim which itself depends from an allowable base claim. Consequently, claim 3 is necessarily allowable as well. For at least these reasons, the Applicant respectfully asserts that *Berstis* does not teach the identical invention of claim 3, and claim 3 is allowable under 35 U.S.C. § 102 over *Berstis*. With respect to claims 12 and 21, the Applicant understands that these claims have been rejected as being drawn to a data processing system, and computer program product respectively including circuits and programming instructions for performing operations paralleling the steps of claim 3. (See Paper No. 3, page 2.) Accordingly, the Applicant respectfully contends that claims 12 and 21 are also allowable under 35 U.S.C. § 102 over *Berstis*.

Claim 28 is directed to a data processing system. The system includes a network, a client coupled to a network, and a server coupled to the network, the client including circuitry operable for sending a request for delivery of software assets over the network to the server. The server includes

circuitry operable for scheduling the request for delayed servicing in response to insufficient system capacity, and, the server also includes circuitry for sending a notification to the client to resend the request according to the scheduling. Claim 28 has been rejected on the identical ground as claim 1. (Paper No. 3, page 2.) As discussed hereinabove, the disclosure in *Berstis* is directed to an agent scheduling function running a network client. The limitation in claim 28 directed to a server coupled to a network including circuitry operable for scheduling the request for delayed servicing... has not been expressly addressed. Furthermore, the teaching in *Berstis* directed to a client agent does not teach the client including circuitry for sending a request for delivery of software assets, nor by its plain terms, the server as recited therein. Because, *Berstis* has not been shown to teach the identical invention of claim 28, the Applicant respectfully asserts that claim 28 is allowable under 35 U.S.C. § 102 over *Berstis*.

Claim 29 depends from claim 28 and recites the data processing system thereof in which the request is scheduled for servicing at a preselected time. Because *Berstis* does not disclose a server including circuitry operable for scheduling the request for delayed servicing, and necessarily fails to disclose that the request is scheduled for servicing at a preselected time. For at least this reason, the Applicant also respectfully asserts that claim 29 is allowable under 35 U.S.C. § 102 over *Berstis*.

Claim 30 is directed to the data processing system of claim 28 in which the client further includes circuitry operable for resetting the request in response to the notification. As discussed hereinabove, *Berstis* teaches that the agent start times are regenerated if a connection is unavailable. Since a connection is unavailable, no requests could have been initiated in the first instance. Therefore, the agent, as disclosed in *Berstis* would not be expected to be operable for resending a request in response to a notification. Furthermore, also discussed hereinabove, no teaching in *Berstis* has been identified that discloses a server sending a notification to a client for resending the request. Because, for at least these reasons, *Berstis* has not been shown to teach the identical invention of claim 30, claim 30 is allowable under 35 U.S.C. § 102 over *Berstis*.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 4-9, 13-18, 23-27 and 32 have been rejected 35 U.S.C. § 102 as being unpatentable over *Berstis* in view of *Guarneri, et al.*, U.S. Patent No. 5,631,907 ("*Guarneri*"). The Applicant respectfully traverses the rejection of claims 4-9, 13-18, 23-27 and 32 under 35 U.S.C. § 103.

As an initial matter, the filing date of the Continued Prosecution Application filed concurrently herewith is subsequent to November 29, 1999. *Berstis* is commonly owned with the instant Application as evidenced on the face of *Berstis* and the assignment of the instant Application recorded at Reel/Frame 9899/0623. Therefore *Berstis* is unavailable as prior art under 35 U.S.C. § 102(e) as applied to the rejection of claims 4-9, 13-18, 23-27 and 32 under 35 U.S.C. § 103. 35 U.S.C. § 103(c); MPEP 706.02(l)(1).

The foregoing notwithstanding, the Applicants respectfully contend the Examiner's responses with respect to the teachings in *Guarneri* do not support the combination of *Berstis* and *Guarneri*. For example, the Examiner contends (with respect to the rejection of claim 4) that "if Berstis' teachings only operated at the client, the teachings of *Guarneri* would clearly show the scheduling or dividing of data could be done at the client or server or vice versa." (Paper No. 5, page 6.) The Examiner's response is conclusory and not supported by objective evidence. The Examiner has not shown that *Berstis* could be so modified to make the claimed invention(s) without either changing the principle of operation thereof, and with a reasonable expectation of success, found in the teachings of the references themselves. See MPEP §§ 2143; 2143.01. Similarly, with respect to claim 6, the Examiner responds that *Berstis* teaches that "a test is run to determine whether the agent is able to obtain one of the limited number of network connections according to some given criteria." (Paper No. 5, page 7.) The Examiner further refers to *Guarneri* for the teaching with respect to a 5-10 minute period between broadcasts. (Paper No. 5, page 7.) However a broadcast is not a network connection, and more particularly is not a determination whether a network connection is available. And neither of these teachings, as recited by the Examiner, refers to a time slot including a first portion having a first preselected proportion of a predetermined network resource capacity,

the first portion comprising a portion reserved for servicing requests in real time, as in, *inter alia*, claim 6. The Examiner further asserts (with respect to claim 8) that "[b]ased on priority given to the start time, correlates to the priority given to the service request for that agent." (Paper No. 5, page 7.) However, there is no teaching in *Berstis* identified as disclosing a priority given to the service request for an agent, and a search of an electronic version of *Berstis* returned no instances of "priority."

The Examiner also responded with several general allegations. These include that the Applicants' arguments fail to comply with 37 C. F. R. § 1.111 because they amount to a general allegation that claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguish...because the Applicants asserted that the express limitations of claim 4 have not been addressed in the rejection thereof. Plainly, where the Examiner does not consider a limitation in the claim, a *prima facie* case has not been made. All claim limitations must be taught or suggested by the references, alone or in combination, and all words must be considered in judging the patentability of the claim. MPEP 2143.03.

IV. AMENDMENT TO CLAIMS 6, 7 15, 16, 24 AND 25

Claims 6, 7 15, 16, 24 and 25 have been rewritten hereinabove to depend, respectively, from claims 3, 12 and 21 which provide the antecedent basis for "time slot."

Respectfully submitted,
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**VERSION TO SHOW CHANGES MADE
IN THE CLAIMS**

(1) Claim 6 has been rewritten as follows:

1 6. (Amended) The method of claim [2] 3 wherein each time slot includes a first portion
2 having a first preselected proportion of a predetermined network resource capacity, said first portion
3 comprising a portion reserved for servicing requests in real time.

(2) Claim 7 has been rewritten as follows:

1 7. (Amended). The method of claim [2] 3 wherein each time slot includes a first portion
2 having a first preselected proportion of a predetermined network resource capacity, said first portion
3 comprising a portion reserved for servicing at least one scheduled request.

(3) Claim 15 has been rewritten as follows:

1 15. (Amended) The data processing system of claim [11] 12 wherein each time slot includes
2 a first portion having a first preselected proportion of a predetermined network resource capacity,
3 said first portion comprising a portion reserved for servicing requests in real time.

(4) Claim 16 has been rewritten as follows:

1 16. (Amended) The data processing system of claim [11] 12 wherein each time slot includes
2 a first portion having a first preselected proportion of a predetermined network resource capacity,
3 said first portion comprising a portion reserved for servicing at least one scheduled request.

(5) Claim 24 has been rewritten as follows:

1 24. (Amended) The program product of claim [20] 21 wherein each time slot includes a first
2 portion having a first preselected proportion of a predetermined network resource capacity, said first
3 portion comprising a portion reserved for servicing requests in real time.

(6) Claim 25 has been rewritten as follows:

1 25. (Amended) The program product of claim [20] 21 wherein each time slot includes a first
2 portion having a first preselected proportion of a predetermined network resource capacity, said first
3 portion comprising a portion reserved for servicing at least one scheduled request.

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